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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,477	09/05/2003	Carey E. Garibay	BEAS-01454US4	8635
23910	7590	06/18/2007		
FLIESLER MEYER LLP 650 CALIFORNIA STREET 14TH FLOOR SAN FRANCISCO, CA 94108			EXAMINER HEWITT II, CALVIN L	
			ART UNIT 3621	PAPER NUMBER
			MAIL DATE 06/18/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/656,477

Applicant(s)

GARIBAY ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :1-17-07,5-26-06,3-11-05,12-15-03.

Status of Claims

1. Claims 1-27 have been examined.

Examiner's Comment

2. Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP §2106 II C; Intel Corp. v. Int'l Trade Comm'n, 20 USPQ2d 1161 (Fed. Cir. 1991); In re Johnston, 77 USPQ2d 1788 (CA FC 2006)).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 7, 8 and 10-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites the limitation "the configuration input screen" in line 2.

There is insufficient antecedent basis for this limitation in the claim. Claim 16 is also rejected as it recites similar language.

Claim 8 recites the limitation "the change of IP address" in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim. Claim 17 is also rejected as it recites similar language.

Claim 10 is directed to a license management system comprising a processor and memory. However, claims 11-17, which depend from claim 10, are directed to either method steps (*Ex Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)) (claims 11, 12 and 16-18) or data (e.g. input configuration information) (claims 13-15) that may or may not be present (*In re Collier*, 158 USPQ 266 (CCPA 1968)), therefore the scope of claim 10 is unclear to one of ordinary skill.

Claims 11-17 are also rejected as each depends from claim 10.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 10-17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Misra et al., U.S. Patent No. 6,189,146.

As per claims 10-17, Misra et al. teach a processor and memory
(column/line 5/3-6/20).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misra et al., U.S. Patent No. 6,189,146.

As per claims 1-27, Misra et al. teach a method comprising providing configuration information concerning a software license (column 6, lines 50-64; column/line 7/25-8/33; column 13, lines 12-23) and maintaining a digital record of the license (column 7, lines 12-21; column 8, lines 35-67; column/line 9/29-10/60). Misra et al. also teach license information such as software environment (e.g. operating system), the number of licenses (e.g. number of CPUs), unique computer identifiers (abstract; column 9, lines 40-50; column 10, lines 50-60; column/line 12/40-13/11) and maintaining a transaction history that changes to the configuration information (column 6, lines 50-64; column 8, lines 35-67; column 16, lines 38-43 and 56-63; column 17, lines 8-25). Misra et al. do not

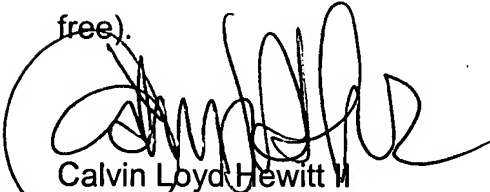
specifically, disclose input fields for the input of configuration information. Singh et al. teach a licensing system where a customer requests a license by input license information into fields on a webpage (column 10, lines 12-27). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Misra et al. and Singh et al. in order to provide a customer with an efficient method for entering data related to a license request ('146, column 6, lines 50-64; column 13, lines 12-32).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:
 - Christiano discloses "node-locked" licenses where a license comprises a unique computer identifier and a computer application can only be run on a computer with a matching computer identifier
10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).

Calvin Lloyd Hewitt
Primary Examiner

May 29, 2007